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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,678	02/25/2002	Stewart L. Atkinson	092246-9035-03	8406

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EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 10/082,678	Applicant(s) ATKINSON ET AL.	
Examiner Dave Willse	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-9, 12, 14-28 and 41-111 is/are pending in the application.
4a) Of the above claim(s) 7-9, 12, 25, 28, 45-47, 50 and 63-111 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4, 6, 14-24, 26, 27, 41-44, 48, 49 and 51-62 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6</u> . | 6) <input type="checkbox"/> Other: _____ |

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Regarding the Information Disclosure Statements, the one listing the foreign patent and other documents was addressed in the Office action of August 8, 2003, to which a copy of the PTO form 1449 was attached. Copies for the remaining Information Disclosure Statements are attached hereto.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6, 14-21, 26, 41, 43, 44, 48, and 51-59 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pusch, US 6,077,301, which discloses a pylon (including adaptor 30), a prosthetic foot 10 and 11, a prosthetic ankle 20, and at least one link (comprising elements 90-93 and 34). Regarding claim 19 and others: column 4, lines 22-24; Figure 1. Regarding claim 21 and others, the ankle 20 “may be made from a carbon composite” (column 4, line 53), and the pyramidal adaptor 30 is inherently of a more rigid material because of its intended function as an adjustable connector to upper portions of the leg prosthesis.

Claims 4, 22-24, 27, 42, 49, and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pusch, US 6,077,301. Regarding claim 4 and others, portions of the prosthetic ankle being substantially straight would have been an obvious step backward or a design

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simplification in order to fit with flat bottom pyramidal adaptors common in the art (in lieu of the less conventional adaptor **30**) along with typical planar nuts and washers that could be used with the screw-bolt **26**. Regarding claim 22, prosthetic leg members of carbon-fiber composites were well known in the art and would have been obvious in view of their low weight and adequate strength, with the ordinary practitioner having been left to select an appropriate material; fiberglass materials were likewise commonly used for ankle and foot members and would have been an obvious alternative to a carbon composite in order to provide amputees with a broader range of choices for dynamic response characteristics. Regarding claims 23 and 24, split foot prostheses are well known in the art and would have been obvious from their disclosed advantages pertaining to improved gait performance, adaptability to rough terrain, etc. Regarding claim 27 and others, an adjustment screw would have been obvious from column 3, lines 42-45.

The Applicant's remarks have been considered. The Applicant asserts that the "link" element of instant claims 1 and 26 is supported by the limit strap **36** in great-grandparent application serial no. 08/602,241, US 5,800,568. The word "link" is defined as "a connecting structure" which can take the form of "a single ring or division of a chain" or "an intermediate rod or piece for transmitting force or motion; *esp.* a short connecting rod with a hole or pin at each end" (*Merriam-Webster's Collegiate Dictionary*, Tenth Edition, 1996). Alternative definitions are "[a] lever or rod transmitting motion in a machine" (*Webster's II New Riverside University Dictionary*, 1984) and "[a]ny connecting piece in a machine, pivoted at the ends" (*The Wordsworth Dictionary of Science & Technology*, 1995). Because of its flexibility (US 5,800,568: column 3, lines 33-37), the limit strap **36** is incapable of transmitting compressive,

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torsional, and lateral forces and does not even transmit tensile forces until it is sufficiently tensioned. Therefore, the limit strap 36 cannot serve as a link under any of the aforementioned definitions. Although the present disclosure uses the term “link” to describe various elements, the definition of such a word must follow the guidelines set forth in MPEP §§ 608.01(o) and 2111.01. Where an Applicant chooses to be his or her own lexicographer and defines terms with special meanings, he or she must set out the special definition explicitly and with “reasonable clarity, deliberateness, and precision” in the disclosure to give one of ordinary skill in the art notice of the change (*Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002); *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed Cir. 2001)). It is the examiner’s contention that even the current application fails to meet these conditions, and there is no question that said great-grandparent application is likewise inadequate because the term “link” is nowhere to be found in its disclosure. Therefore, the examiner refuses to grant an effective invention date earlier than February 25, 2002, for claims 1-28 (among others).

Regarding the Pusch patent applied above, the Applicant asserts that “Pusch does not disclose, teach, or suggest the pylon and the prosthetic ankle being an integral unit” (Paper No. 6, page 28, last three lines). The term “integral” was held not to be limited to a fabrication of the parts from a single piece of metal, but was inclusive of other means of maintaining the parts fixed together as a single unit (*In re Larson et al.*, 144 USPQ 347). “Integral” is sufficiently broad to embrace constructions united by such means as fastening and welding (*In re Hotte*, 177 USPQ 326).

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is (703) 308-2903. The examiner can normally be reached Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Dave Willse
Primary Examiner
Art Unit 3738